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EXAMINER

RETTA, YEHDEGA

ART UNIT

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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/687,499	Applicant(s) WINSLADE ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed January 16, 2009. Claims 34 and 38 are amended. Claims 34-39 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 recites providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale *after the offering by a second system of a second party*. The specification however discloses (see fig. 6-9 and related paragraphs) a seller offering an item for sell and a rebate, a coupon or promotion amount is associated with the item and a purchase request from a buyer for the item being offered online is received and a buyer is require to pay a purchase amount corresponding to the sales price amount less the rebate, coupon or promotion amount for item. Also on pages 44-50, the specification teaches a first party offers an item online for sale at a sale price; a coupon of the second party is associated with the item; a purchase request is received from a buyer for the item

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being offered online and the purchase request is responded to by requiring the buyer to pay a purchase amount corresponding to the sales price amount less the coupon amount for the item.

The specification does not provide support for providing the portal after the offering by a second system of a second party **or** the buyer can search for promotion from the first party after the offering by the second system of a second party.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34, as amended recites, providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale *after the offering by a second system of a second party*. It is unclear if the portal is provided after the offering by the second party or the user can search after the offering by the second party.

Claim 38 now recites wherein the transaction fee is collected from the buyer by charging ***an amount more than the sale price less the promotional amount***. Claim 36 recites, responding to the online purchase by *collecting from the buyer to a sales price amount less the promotion amount* and also *collecting a transaction fee*. As claimed in claim 36 the transaction fee is in addition to the purchase amount (sales amount minus the promotion amount) and the transaction fee as claimed in claim 38 is an amount more than the purchase amount. Therefore, two different amounts are collected from the buyer; a purchase amount (a sale price minus a promotion

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amount) and a transaction fee (an amount that is more than the purchase amount). As understood by the examiner, for example, if the sale amount is \$2.00 and the promotion amount is 0.50 cents, the buyer is charged \$1.50 as a purchase amount and also an amount more than \$1.50 as a transaction fee, i.e., a total amount which exceeds \$3.00. Therefore it is unclear if Applicant intended to claim that the total purchase amount, which includes the transaction fee, is more than the sale price less the promotion amount or the transaction fee by itself is more than the sales price less the promotion (more than the purchase amount).

Claim 38 recites the limitation "promotional amount". There is insufficient antecedent basis for this limitation in the claim. Claim 36 recites a "promotion amount" not a "promotional amount".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US 6,915,271).

Regarding claim 34, Meyer teaches offering by a second system of a second party (merchants) items for sale at a sales price amount (see fig. 31-35 col. 39 line 55 to col. 41 line 22); providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale, the promotion having a

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promotion amount (fig. 19-34); receiving, by the second system (merchants), online purchase request from a buyer for at least one item (buy now) (see col. 40 line 64 to col. 41 line 40); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 41 line 66 to col. 42 line 25) and electronically communicating, by the second system to the first system, an indication regarding the collection from the buyer of the purchase amount (see col. 40 line 64 to col. 41 line 40, col. 42 line 1-64).

Regarding claim 35, Meyer teaches offering, by a second system of a second party, an item for sale online at a sales price amount (see fig. 33 and 35 also col. 40 line 64 to col. 41 line 40), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36) responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 42 lines 1-36); and causing, by the second system, shipment by the second party of the item for sale to the customer (see col. 41 lines 22-40).

Regarding claim 36, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free

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Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36); and collecting, by the second system, a transaction fee associated with the online purchase request (when the "Buy Now" button is pressed the buyer may go to the site on the Web for purchasing the goods or services which may be the same site one is on or at a different Web location corresponding)(see col. 40 line 63 to col. 41 line 20) .

Regarding claims 37-39, Meyer teaches wherein the transaction fee is collected from the buyer (see col. 40 line 63 to col. 41 line 20, col. 42 lines 1-41).

Response to Arguments

Applicant's arguments filed January 16, 2009 have been fully considered but they are not persuasive.

Regarding claim 34 applicant argues that the Meyer's use of a "buy now" option as part of a displayed incentive is different from "offering, by a second system of a second party, an item for sale online at a sale price amount" ... because, in relied upon "buy now", example any purported portal is provided before, and not after, any purported offering, by a second system of a second party, an item for sale online at a sales price amount. Examiner would like to point out that the claim does not recite providing the portal after the user's selection of the item for sale or

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after user indication of purchase. The claim merely recites offering the item for sale and providing the portal after the offering which is does not indicate if the offering and portal are provided to a user or displayed to a user one after another. As claimed the purchase request can be requested from the offering of the item for sale or from the portal. Applicant also argues that in the presently claimed subject matter the buyer can search for promotions associated with the item for sale, where the item for sale is offered for sale at a sales price amount. Examiner would like to point out that in Meyer the item are also previously offered for sale at the merchant's website or store, before the promotion is issued by the merchants and provided to the promotional website. Applicant asserts to the extent Meyer, *arguendo*, would offer an item for sale at a sales-price amount, that amount would not appear to be known-or seen until after the incentive were located and the "buy now" feature selected. Examiner would like to point out that the claim recites offering an item for sale online at a sales price. As claimed there is no clear indication that the item is offered online nor is it indicated that the price is displayed or is known to the buyer. The claim just recites that a second system offers an item (for sale online at a sales price). Meyer teaches that once the user clicks on the "Buy Now" button, to purchase the product with the incentive, the user is directed to a web site for purchasing the product (which is offered for sale from the merchant) from the same site or at a different Web location or corresponding to an offline merchant that does not have a web site (see col. 40 line 63 to col. 41 line 21).

Regarding claim 35, applicant argues that the cited portion of Meyer does not teach the same party/system receiving the online purchase request from a buyer, and responding by collecting a purchase amount from the buyer, and causing shipment (by the same party), let alone "receiving, by the second system, an online purchase request from a buyer for the item for sale;

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responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and causing, by the second system, shipment by the second party of the item for sale to the customer" as claimed. Contrary to applicant's argument Meyer teaches a new pop-up purchase screen is displayed which includes a hyperlinks to all the online merchants and the member is automatically transferred to the on store to purchase the goods or services (see col. 41 lines 7-40). Therefore, the online purchase request is received by the second system from the buyer directly or indirectly.

Regarding claims 36-39, claim 36 recites collecting transaction fee associated with online purchase. Applicant's specification does not explicitly correlate the transaction fee to surcharge or service charge, therefore, the term "transaction fee" is interpreted more broadly than what applicant's interpretation is. Claim 37 recites wherein the transaction fee is collected from the buyer and in claim 38 it was recited that the transaction fee is applied to reduce the promotion amount. If the term "transaction fee" is interpreted to mean surcharge or service charge paid by buyer (collected from buyer), the transaction fee or service fee does not reduce the promotional amount or sale amount, since it is an amount paid in addition to the purchase amount (sale amount minus the promotional amount). However applicant by amending claim 38 to further define the term "transaction fee", which is a fee collected from the buyer by charging an amount more than the sales price less than the promotion amount, it means that an additional amount is charged. However it does not mean a surcharge or service charge. It can also mean that sales tax is applied, in response to the purchase request. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

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Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Applicant's specification does not provide correlation between the "transaction fee" and "surcharge fee" or "service fee".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622